

Response Under 37 CFR 1.116

Expedited Procedure

Examining Group 3600

Application No.: 10/773,912

Paper Dated: October 25, 2007

In Reply to: USPTO Office Action dated July 6, 2007

Attorney Docket No.: 4461-040040

REMARKS

Claims 1-22 are pending in this application. No claims have been cancelled or added. Claims 1 and 13 have been amended to clarify that the server is functionally distinct from the first computer and that the server is operated by a service provider. This limitation was evident from the drawings and was implied by virtue of previously amended claim 1 requiring that the server be remote from the first computer. Claims 1 and 13 have also been amended to claim that the second computer is operated by a patient. Support for these amendments may be found in the specification in paragraphs [0025] and FIG. 1. Of note, the formatting of claim 1 has been changed for ease of readability. Accordingly, no new subject matter is believed to have been added by these amendments. Claims 1-22 still remain in this application.

The Examiner incorrectly indicates that the outstanding Office Action is a final Office Action. Specifically, the Examiner states that due to Applicant's amendments with respect to claims 1 and 13, new grounds of rejection needed to be made and the Office Action needed to be made final. However, Applicant has indicated in his previous response that even without the clarifying claim amendments, the prior art still did not anticipate the invention. Any newly cited prior art by the Examiner should have addressed Applicant's amendments (i.e., the new search was done for purposes of finding prior art that addresses the new limitations). This would have been evidence of the Applicant's amendments being such that a new search was truly required. In contrast, however, the Examiner appears to have only performed a renewed search for finding more relevant prior art. This is shown by virtue of the fact that the new reference (i.e., Munoz) that is now applied to independent claims 1 and 13 could have been equally applied to original independent claims 1 and 13. Accordingly, Applicant requests that the final rejection be withdrawn and that Applicant be afforded the opportunity to make additional arguments and amendments that the Examiner must fully consider before issuing a truly final Office Action.

35 U.S.C. §103 Rejections

Independent claims 1 and 13 stand rejected under 35 U.S.C. § 103(a) for obviousness over newly cited U.S. Patent Application Publication No. 2002/0052760 to

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Munoz et al. in view of previously cited U.S. Patent Application Publication No. 2002/0065758 to Henley.

The Munoz publication appears to disclose a system in which a physician sends out a patient's prescription to various pharmacies for purposes of obtaining bids on the prescription. However, the system in the Munoz publication is not disclosed in the context of a service provider, as is the case with the claimed invention (Compare FIG. 14 of the Munoz publication to FIG. 1 of Applicant's application). Specifically, the pharmacies in the Munoz system send the bids directly to the physician, who then passes on a physically *printed* bid report to a patient (See paragraph [0067]). There is no service provider to serve as an intermediary for receiving bids, conveying them to the patient, and informing a specified pharmacy to fill a prescription.

It appears to Applicant that the Examiner equates the claimed "server" (service provider) limitation to the computers that are operated by the physician. It also appears that the Examiner equates the claimed "second computer" (patient's computer used to retrieve the bids) to a computer configured to receive the bids at the physician's office. To further define the relationship of the aforementioned entities, Applicant has amended claims 1 and 13 to clarify that the server is functionally distinct from the first computer, that the server is operated by a service provider, and that the second computer is operated by a patient.

The deficiency of the system in the Munoz publication, among other things, lies in the fact that physicians are charged with the task of collecting, reviewing, and forwarding the bids to the patient, in paper form, nonetheless. In practice, the physicians will not have time to review all the bids and the workload will be increased for them. This, in effect, increases the cost of the prescription (i.e., increased overhead costs need to be passed on to the patient), which is opposite to the intended goal of the present invention. The service provider of the present invention undertakes this increased overhead. The patient is allowed to view and select from the offered bids via their own computer (i.e., second computer). The physician's duties therefore only extend to submission of the prescription, which is no different or incurs greater effort and resources, than is currently employed by a physician. It is more effective to allow the patient to view and select from the various bids because multiple criteria is to be taken into account. The patient's decision will be based, among

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other things, on geographic location, proximity to commuting routes, immediate availability, discount cards with some specific pharmacies, etc. It is not a single criteria choice (i.e., cost), as discussed in the Munoz publication. For example, if the cost of the medication was the only criteria, all patients would drive to Canada for their prescriptions. However, the cost of gas and time budgeting are part of the equation, as well.

The Examiner has acknowledged that the act of selecting from among various bids using the second computer to instruct the winning pharmacy to fill the prescription is not disclosed in the Munoz publication. However, the Examiner attempts to equate these undisclosed limitations to teachings of the Henley publication. Specifically, the Examiner asserts that paragraphs [0101-0102] disclose this aspect of a “second computer”. In the Henley publication, in the aforementioned paragraphs, there is mention of “registered buyers” (e.g., patients) who have the ability to log-in to a computer system using their own computer for purposes of buying prescriptions at offered prices set forth by vendors. However, this disclosure relates to a traditional auction, as opposed to the claimed reverse auction of the present invention. Applicant’s assertion is supported by the fact that “registered buyers” in the Henley system can outbid other “registered buyers”. As discussed in the Henley publication, a first buyer submits an offer for a service, a second buyer views the first buyer’s offer, and the second buyer submits his own offer to purchase the service at a higher price than the first offer (See paragraph [0101]). In contrast, claims 1 and 13 require that the second computer (operated by a patient) is configured to select between two or more bids. In other words, the bids are not entered by the patient, as they have been entered by the pharmacies who wish to sell the prescription to the patient. As already stated, the claimed *reverse* auction of the present invention is not disclosed in the Henley publication, and therefore, contrary to the Examiner’s assertion, the Henley publication fails to show a “second computer” configured to select from among various bids and to instruct the winning pharmacy to fill the prescription.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As the secondary reference (i.e., the Henley publication) does not anticipate the limitation, among others, of a second computer configured to select from

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among various bids and to instruct the winning pharmacy to fill the prescription, a *prima facie* case of obviousness cannot be made.

Independent claim 17 continues to stand rejected under 35 U.S.C. § 103(a) for obviousness over the Henley publication in view of U.S. Patent Application Publication No. 2001/0039503 to Chan et al. and further in view of U.S. Patent Application Publication No. 2002/0010679 to Felsher. The Examiner asserts that Applicant's arguments are unpersuasive. The Examiner states that Applicant does "not claim that the application [residing on a CD medium] executes automatically or by some process that causes the application to execute once the medium is detected by the computer", but rather, that Applicant claims "that the application is configured to execute once the portable storage medium interfaces with the computer." Applicant does not find this distinction relevant because the Examiner has still failed to provide a reference that shows the auto-execution aspect, as set forth in claim 17.

The Examiner offers that he would have agreed with Applicant's argument had Applicant claimed a computer system configured to execute the program, rather than claiming an application that is configured to auto-execute. Just because the Examiner deems that additional steps take place in the auto-execution of the application on the medium, this has no bearing on the fact that the Examiner has not met his burden of proof in providing prior art references disclosing the limitations of claim 17. In other words, since the Examiner has not shown how each limitation is anticipated in one or more references, the Examiner cannot set forth a *prima facie* case of obviousness (See *In re Royka*, supra).

The remaining dependent claims are rejected, either alone or in combination with, the aforementioned prior art and optionally in view of United States Patent Application Publication No. 2003/0154376 to Hwangbo. Applicant deems the rejections of the dependent claims as moot in light of the aforementioned arguments made with respect to the independent claims.

For the foregoing reasons, Applicant believes that the subject matter of independent claims 1, 13, and 17 are not rendered obvious by the Munoz publication in view of the Henley publication. Reconsideration of the rejections of claims 1, 13, and 17 is respectfully requested. Claims 2-12, 14-16, and 18-22 depend from and add further limitations to independent claims 1, 13, and 17, respectively and are believed to be patentable

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for the reasons discussed hereinabove in connection with independent claims 1, 13, and 17.

Reconsideration of the rejections of claims 2-12, 14-16, and 18-22 is respectfully requested.

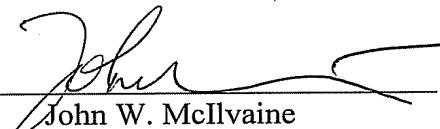
CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-22 are respectfully requested.

Respectfully submitted,

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